

14202 U.S. PTO  
08/19/03

Practitioner's Docket No. 12724.00009 (Nicholls et al.)

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Box Patent Application  
Assistant Commissioner of Patents  
Washington, D.C. 20231

**NEW APPLICATION TRANSMITTAL**

Transmitted herewith for filing is the patent application of

Inventor(s): MARK H. NICHOLLS, SIDNEY O. NICHOLLS  
and DOUGLAS L. PULLIN

WARNING: 37 C.F.R. §1.41(a)(1) points out:

"(a) A patent is applied for in the names of actual inventor or inventors.

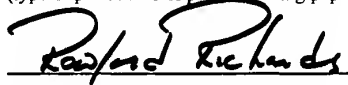
"(1) The inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by § 1.63, except as provided for in § 1.53(d)(4) and § 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(b), unless a petition under this paragraph accompanied by the fee set forth in § 1.17(i) is filed supplying or changing the name or names of the inventor or inventors."

For (title): OPTICALLY MARKED SURFACE

**CERTIFICATION UNDER 37 CFR 1.10\***  
**(Express Mail label number is mandatory.)**  
**(Express Mail certification is optional.)**

I hereby certify that this New Application Transmittal and the documents referred to as attached therein are being deposited with the United States Postal Service on this date August 19, 2003, in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number EL558326296US, addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

Rowland Richards, Reg. No. 42,104  
(type or print name of person mailing paper)

  
(Signature of person mailing paper)

WARNING: Certificate of mailing (first class) or facsimile transmission procedures of 37 C.F.R. 1.8 cannot be used to obtain a date of mailing or transmission for this correspondence.

WARNING: Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 CFR 1.10(b).

"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

17302 U.S. PTO  
10/643336  
08/19/03

## 1. Type of Application

This new application is for a(n) (check one applicable item below):

☐ Original (nonprovisional)

☐ Design

☐ Plant

WARNING: Do not use this transmittal for a completion in the U.S. of an International Application under 35 U.S.C. 371(c)(4), unless the International Application is being filed as a divisional, continuation or continuation-in-part application.

WARNING: Do not use this transmittal for the filing of a provisional application.

NOTE: If one of the following 3 items apply, then complete and attach ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF A PRIOR U.S. APPLICATION CLAIMED and a NOTIFICATION IN PARENT APPLICATION OF THE FILING OF THIS CONTINUATION APPLICATION.

☒ Divisional.

☐ Continuation.

☐ Continuation-in-part (C-I-P).

## 2. Benefit of Prior U.S. Application(s) (35 U.S.C. 119(e), 120, or 121)

NOTE: A nonprovisional application may claim an invention disclosed in one or more prior filed copending nonprovisional applications or copending international applications designating the United States of America. In order for a nonprovisional application to claim the benefit of a prior filed copending nonprovisional application or copending international application designating the United States of America, each prior application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. Each prior application must also be:

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or

(ii) Complete as set forth in § 1.51(b); or

(iii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16; or

(iv) Entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(f) within the time period set forth in § 1.53(f).

37 C.F.R. § 1.78(a)(1).

NOTE: If the new application being transmitted is a divisional, continuation or a continuation-in-part of a parent case, or where the parent case is an International Application which designated the U.S., or benefit of a prior provisional application is claimed, then check the following item and complete and attach ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

WARNING: If an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. 120, 121 or 365(c), the 20-year term of the application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 U.S.C. 120, 121 or 365(c). (35 U.S.C. 154(a)(2) does not take into account, for the determination of the patent term, any application on which priority is claimed under U.S.C. 119, 365(a) or 365(b). For a c-i-p application, applicant should review whether any claim in the patent that will issue is supported by an earlier application and, if not, the applicant should consider canceling the reference to the earlier filed application. The term of a patent is not based on a claim-by-claim approach. See Notice of April 14, 1995, 60 Fed. Reg. 20,195, at 20,205.

WARNING: When the last day of pendency of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, any nonprovisional application claiming benefit of the provisional application must be filed prior to the Saturday, Sunday, or Federal holiday within the District of Columbia. See 37 C.F.R. §1.78(a)(3).

- [x] The new application being transmitted claims the benefit of prior U.S. application(s).  
Enclosed are ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE  
BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

### 3. Papers Enclosed

- A. Required for filing date under 37 C.F.R. § 1.53(b) (Regular) or 37 C.F.R. § 1.153  
(Design) Application

14 Pages of specification

2 Pages of claims

8 Sheets of drawing

WARNING: DO NOT submit original drawings. A high quality copy of the drawings should be supplied when filing a patent application. The drawings that are submitted to the Office must be on strong, white, smooth, and non-shiny paper and meet the standards according to § 1.84. If corrections to the drawings are necessary, they should be made to the original drawing and a high-quality copy of the corrected original drawing then submitted to the Office. Only one copy is required or desired. For comments on proposed then-new 37 CFR 1.84, see Notice of March 9, 1988 (1990 O.G. 57-62).

NOTE: "Identifying indicia, if provided, should include the application number or the title of the invention, inventor's name, docket number (if any), and the name and telephone number of a person to call if the Office is unable to match the drawings to the proper application. This information should be placed on the back of each sheet of drawing a minimum distance of 1.5 cm. (5/8 inch) down from the top of the page." (37 C.F.R. 1.84(c)).

(complete the following, if applicable)

- ☐ The enclosed drawing(s) are photograph(s), and there is also attached a "PETITION TO  
ACCEPT PHOTOGRAPH(S) AS DRAWING(S)". 37 C.F.R. 1.84(b).

☒ formal

☐ informal

- B. Other Papers Enclosed

     Pages of declaration and power of attorney

1 Pages of abstract

     Other

#### **4. Additional papers enclosed**

- ☐ Amendment to claims
  - ☐ Cancel in this applications claims \_\_\_\_\_ before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)
  - ☐ Add the claims shown on the attached amendment. (Claims added have been numbered consecutively following the highest numbered original claims.)
- ☐ Preliminary Amendment
- ☐ Information Disclosure Statement (37 CFR 1.98)
- ☐ Form PTO-1449 (PTO/SB/08A and 08B)
- ☐ Citations
- ☐ Declaration of Biological Deposit
- ☐ Submission of "Sequence Listing," computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence.
- ☐ Authorization of Attorney(s) to Accept and Follow Instructions from Representative
- ☐ Special Comments
- ☐ Other

#### **5. Declaration or oath (including power of attorney)**

NOTE: A newly executed declaration is not required in a continuation or divisional application provided that the prior nonprovisional application contained a declaration as required, the application being filed is by all or fewer than all the inventors named in the prior application, there is no new matter in the application being filed, and a copy of the executed declaration filed in the prior application (showing the signature or an indication thereon that it was signed) is submitted. The copy must be accompanied by a statement requesting deletion of the names of person(s) who are not inventors of the application being filed. If the declaration in the prior application was filed under § 1.47, then a copy of that declaration must be filed accompanied by a copy of the decision granting § 1.47 status or, if a nonsigning person under § 1.47 has subsequently joined in a prior application, then a copy of the subsequently executed declaration must be filed. See 37 C.F.R. §§ 163(d)(1)-(3).

NOTE: A declaration filed to complete an application must be executed, identify the specification to which it is directed, identify each inventor by full name including family name and at least one given name, without abbreviation together with any other given name or initial, and the residence, post office address and country or citizenship of each inventor, and state whether the inventor is a sole or joint inventor. 37 C.F.R. § 1.63(a)(1)-(4).

☐ Enclosed

Executed by  
(check **all** applicable boxes)

☒ inventor(s).

☐ legal representative of inventor(s). 37 CFR 1.42 or 1.43.

☐ joint inventor or person showing a proprietary  
interest on behalf of inventor who refused to sign  
or cannot be reached.

☐ This is the petition required by 37 CFR 1.47 and the statement required by 37 CFR  
1.47 is also attached. See item 13 below for fee.

☒ Not Enclosed.

NOTE: Where the filing is a completion in the U.S. of an International Application or where the completion of the U.S. application contains subject matter in addition to the International Application, the application may be treated as a continuation-in-part, as the case may be, utilizing ADDED PAGE FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION CLAIMED.

☐ Application is made by a person authorized under 37 CFR 1.41(c) on behalf of all  
the above named inventor(s).

(The declaration or oath, along with the surcharge required by 37 CFR 1.16(e)  
can be filed subsequently.)

☐ Showing that the filing is authorized.  
(not required unless called into question. 37 CFR 1.41(d))

## 6. Inventorship Statement

WARNING: If the names inventors are each not the inventors of all the claims an explanation, including the ownership of the various claims at the time the last claimed invention was made, should be submitted.

The inventorship for all the claims in this application are:

☒ The same.

or

☐ Not the same. An explanation, including the ownership of the various claims at the time the  
last claimed invention was made,

☐ is submitted.

☐ will be submitted.

## 7. Language

NOTE: An application including a signed oath or declaration may be filed in a language other than English. An English translation of the non-English language application and the processing fee of \$130.00 required by 37 CFR 1.17(k) is required to be filed with the application, or within such time as may be set by the Office. 37 CFR 1.52(d).

☒ English

☐ Non-English

☐ The attached translation includes a statement that the translation is accurate. 37 C.F.R. 1.52(d).

## 8. Assignment

☐ An assignment of the invention to \_\_\_\_\_

☐ is attached. A separate ☐ "COVER SHEET FOR ASSIGNMENT (DOCUMENT) ACCOMPANYING NEW PATENT APPLICATION" or ☐ FORM PTO 1595 is also attached.

☐ will follow.

NOTE: "If an assignment is submitted with a new application, send two separate letters-one for the application and one for the assignment." Notice of May 4, 1990 (1114 O.G. 77-78).

WARNING: A newly executed "CERTIFICATE UNDER 37 CFR 3.73(B)" must be filed when a continuation-in-part application is filed by an assignee. Notice of April 30, 1993, 1150 O.G. 62-64.

## 9. Certified Copy

Certified copy(ies) of application(s)

(COUNTRY)	(APPLN. NO.)	(FILED)
(COUNTRY)	(APPLN. NO.)	(FILED)
(COUNTRY)	(APPLN. NO.)	(FILED)

from which priority is claimed

☐ is (are) attached.

☐ will follow.

NOTE: The foreign application forming the basis for the claim for priority must be referred to in the oath or declaration. 37 CFR 1.55(a) and 1.63.

NOTE: This item is for any foreign priority for which the application being filed directly relates. If any parent U.S. application or International Application from which this application claims benefit under 35 U.S.C. 120 is itself entitled to priority from a prior foreign application then complete item 18 on the ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

## 10. Fee Calculation (37 CFR 1.16)

### A. ☒ Regular application

CLAIMS AS FILED			
Number filed	Number Extra	Rate	Basic Fee 37 CFR 1.16(a) \$750.00
Total Claims (37 CFR 1.16(c))	13 - 20 = -0- X	18.00	-0-
Independent Claims (37 CFR 1.16(c))	4 - 3 = -0- X	84.00	84.00
Multiple dependent claims(s), if any (37 CFR 1.16(d))	+	280.00	-0-

☐ Amendment cancelling extra claims enclosed.

☐ Amendment deleting multiple-dependencies enclosed.

☐ Fee for extra claims is not being paid at this time.

NOTE: If the fees for extra claims are not paid on filing they must be paid or the claims cancelled by amendment, prior to the expiration of the time period set for response by the Patent and Trademark Office in any notice of fee deficiency. 37 CFR 1.16(d).

Filing Fee Calculation \$834.00

### B. ☐ Design application (\$330.00-37 CFR 1.16(f))

Filing Fee Calculation \$           

### C. ☐ Plant application (\$540.00-37 CFR 1.16(g))

Filing fee calculation \$

## 11. Small Entity Statement(s)

- ☒ Statement(s) that this is a filing by a small entity under 37 CFR 1.9 and 1.27 is (are) attached.

WARNING: "Status as a small entity must be specifically established in each application or patent in which the status is available and desired. Status as a small entity in one application or patent does not affect any other application or patent, including applications or patents which are directly or indirectly dependent upon the application or patent in which the status has been established. The refiling of an application under § 1.53 as a continuation, division, or continuation-in-part (including a continued prosecution application under § 1.53(d)), or the filing of a reissue application requires a new determination as to continued entitlement to small entity status for the continuing or reissue application. A nonprovisional application claiming benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) of a prior application, or a reissue application may rely on a statement filed in the prior application or in the patent if the nonprovisional application or the reissue application includes a reference to the statement in the prior application or in the patent or includes a copy of the statement in the prior application or in the patent and status as a small entity is still proper and desired. The payment of the small entity basic statutory filing fee will be treated as such a reference for purposes of this section." 37 C.F.R. § 1.28(a)(2).

(complete the following, if applicable)

- ☒ Status as a small entity was claimed in prior application

09 / 844,237, filed on April 25, 2001, from which benefit is being claimed for this application under:

35 U.S.C. ☐ 119(e),

☐ 120,

☐ 121,

☐ 365(c),

and which status as a small entity is still proper and desired.

- ☐ A copy of the statement in the prior application is included.

Filing Fee Calculation (50% of A, B or C above) \$417.00

NOTE: Any excess of the full fee paid will be refunded if small entity status is established and a refund request are filed within 2 months of the date of timely payment of a full fee. The two-month period is not extendable under § 1.136. 37 CFR 1.28(a).

## 12. Request for International-Type Search (37 CFR 1.104(d))

(complete, if applicable)

- ☐ Please prepare an international-type search report for this application at the time when national examination on the merits takes place.

## 13. Fee Payment Being Made At This Time

- ☐ Not Enclosed



☐ No filing fee is to be paid at this time. (This and the surcharge required by 37 C.F.R. 1.16(e) can be paid subsequently.)

☒ Enclosed

☒ Filing fee \$ 417.00

☐ Recording assignment (\$40.00; 37 CFR 1.21(h)) (See attached "COVER SHEET FOR ASSIGNMENT ACCOMPANYING NEW APPLICATION".) \$ \_\_\_\_\_

☐ Petition fee for filing by other than all the inventors or person on behalf of the inventor where inventor refused to sign or cannot be reached. (\$130.00; 37 CFR 1.47 and 1.17(h)) \$ \_\_\_\_\_

☐ For processing an application with a specification in a non-English language. (\$130.00; 37 CFR 1.52(d) and 1.17(k)) \$ \_\_\_\_\_

☐ Processing and retention fee (\$130.00; 37 CFR 1.53(d) and 1.21(l)) \$ \_\_\_\_\_

☐ Fee for international-type search report (\$40.00; 37 CFR 1.21(e)). \$ \_\_\_\_\_

NOTE: 37 CFR 1.21(l) establishes a fee for processing and retaining any application that is abandoned for failing to complete the application pursuant to 37 CFR 1.53(f) and this, as well as the changes to 37 CFR 1.53 and 1.78(a)(1), indicate that in order to obtain the benefit of a prior U.S. application, either the basic filing fee must be paid, or the processing and retention fee of S 1.21(l) must be paid within 1 year from notification under § 53(f).

Total fees enclosed \$ 417.00

#### 14. Method of Payment of Fees

☒ Check in the amount of \$417.00

☐ Charge Account No. \_\_\_\_\_ in the amount of \$ \_\_\_\_\_. A duplicate of this transmittal is attached.

NOTE: Fees should be itemized in such a manner that it is clear for which purpose the fees are paid. 37 CFR 1.22(b).

#### 15. Authorization to Charge Additional Fees

WARNING: If no fees are to be paid on filing the following items should not be completed.

WARNING: Accurately count claims, especially multiple dependent claims, to avoid unexpected high charges. If extra claim charges are authorized.

☒ The Commissioner is hereby authorized to charge the following additional fees by this paper and during the entire pendency of this application to Account No. 19-3320:

☒ 37 C.F.R. 1.16(a), (f) or (g) (filing fees)

☒ 37 C.F.R. 1.16(b), (c) and (d) (presentation of extra claims)

NOTE: Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims cancelled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 CFR 1.16(d)), it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.

☒ 37 C.F.R. 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application)

☒ 37 C.F.R. §§ 1.17(a)(1)-(5) (extension fees pursuant to § 1.136(a)).

☒ 37 C.F.R. 1.17 (application processing fees)

NOTE: "...A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission." 37 C.F.R. § 1.13(a)(3).

☐ 37 C.F.R. 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 CFR 1.311(b))

NOTE: Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the notice of allowance. 37 CFR 1.311(b).

NOTE: 37 CFR 1.28(b) requires "Notification of any change in status resulting in loss of entitlement to small entity status must be filed in the application . . . prior to paying, or at the time of paying, . . . issue fee. . . ." From the wording of 37 CFR 1.28(b), (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity.

## 16. Instructions As To Overpayment

NOTE: "... Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amounts; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account." 37 C.F.R. § 1.26(a).

☒ Credit Account No. 19-3320

☐ Refund

Respectfully submitted,

PHILLIPS, LYTLE, HITCHCOCK,  
BLAINE & HUBER LLP

By 

Rowland Richards, Esq.

Reg. No. 26,587

3400 HSBC Center

Buffalo, New York 14203

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Telecopier: (716) 852-6100

Attorneys for Applicant(s)

Customer No. 001342

☐ **Incorporation by reference of added pages**

(check the following item if the application in this transmittal claims the benefit of prior U.S. application(s) (including an international application entering the U.S. stage as a continuation, divisional or C-I-P application) and complete and attach the ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED)

- ☒ Plus Added Pages For New Application Transmittal Where Benefit Of Prior U.S. Application(s) Claimed

Number of pages added 8

- ☐ Plus Added Pages For Papers Referred To In Item 4 Above

Number of pages added \_\_\_\_\_

- ☐ Plus added pages deleting names of inventor(s) named in prior application(s) who is/are no longer inventor(s) of the subject matter claimed in this application.

Number of pages added \_\_\_\_\_

- ☐ Plus "Assignment Cover Letter Accompanying New Application"

Number of pages added \_\_\_\_\_

**☐ Statement Where No Further Pages Added**

(if no further pages form a part of this Transmittal, then end this Transmittal with this page and check the following item.)

☐ This transmittal ends with this page.

1314801.1

ADDED PAGES FOR APPLICATION TRANSMITTAL WHERE BENEFIT OF  
PRIOR U.S. APPLICATION(S) CLAIMED  
(37 C.F.R. § 1.78)

17. Relate Back

**WARNING:** If an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. § 120, 121 or 365(c), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 U.S.C. § 120, 121 or 365(c). (35 U.S.C. § 154(a)(2) does not take into account, for the determination of the patent term, any application on which priority is claimed under 35 U.S.C. § 119, 365(a) or 365(b).) For a c-l-p application, applicant should review whether any claim in the patent that will issue is supported by an earlier application and, if not, the applicant should consider canceling the reference to the earlier filed application. The term of a patent is not based on a claim-by-claim approach. See Notice of April 14, 1995, 60 Fed. Reg. 20,195, at 20,205.

(complete the following, if applicable)

☒ Amend the specification by inserting, before the first line following the title, the following sentence:

A. 35 U.S.C. § 119(e)

NOTE: 37 C.F.R. § 1.78(a)(4) and (5):

"(4) A nonprovisional application, other than for a design patent, or an international application designating the United States of America may claim an invention disclosed in one or more prior-filed provisional applications. In order for an application to claim the benefit of one or more prior-filed provisional applications, each prior-filed provisional application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed provisional application must be entitled to a filing date as set forth in § 1.53(c), and the basic filing fee set forth in § 1.16(k) must be paid within the time period set forth in § 1.53(g).

"(5)(i) Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed provisional applications must contain or be amended to contain a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed provisional application. These time periods are not extendable. Except as provided in paragraph (a)(6) of this section, the failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e) to such prior-filed provisional application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or

(B) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence following the title."

(Added Pages for Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed [4-1.4]

—page 1 of 8)

- ☐ "This application claims the benefit of U.S. Provisional Application(s) No(s):

**APPLICATION NO(S):      FILING DATE**

\_\_\_\_\_/\_\_\_\_\_"  
\_\_\_\_\_/\_\_\_\_\_"  
\_\_\_\_\_/\_\_\_\_\_"

**WARNING:** 37 C.F.R. § 1.78(5)(iv): "(iv) If the prior-filed provisional application was filed in a language other than English and an English-language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application or the later-filed nonprovisional application, applicant will be notified and given a period of time within which to file an English-language translation of the non-English-language prior-filed provisional application and a statement that the translation is accurate. In a pending nonprovisional application, failure to timely reply to such a notice will result in abandonment of the application."

### **Language of Prior Filed Provisional Application**

*(Supply information for each provisional whose benefit is being claimed)*

The above identified prior filed provisional application whose benefit is being claimed  
was filed in the English language

- ☐ was filed in a language other than English and an English translation along with a statement that the translation is accurate was filed in the provisional application
- ☐ was filed in a language other than English and an English translation along with a statement that the translation is accurate is filed herewith

### **B. 35 U.S.C. Sections 120, 121 and 365(c)**

**WARNING:** The applicable provisions for the time and manner of claiming the benefit of a prior U.S. application filing date are set forth in 37 C.F.R. § 1.78(a)(1) and (2) as follows:

"(a)(1) A nonprovisional application or international application designating the United States of America may claim an invention disclosed in one or more prior-filed copending nonprovisional applications or international applications designating the United States of America. In order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed application must be:

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or

(ii) Complete as set forth in § 1.51(b); or

(iii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16; or

(iv) Entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(f) within the time period set forth in § 1.53(f).

(Added Pages for Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed [4-1.4]

—page 2 of 8)

(2)(i) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

- (A) An application for a design patent;
  - (B) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or
  - (C) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.
- (iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence following the title.
- (iv) The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number."

☒ "This application is a

- ☐ continuation
- ☐ continuation-in-part
- ☒ divisional

of copending application(s)

- ☒ application number 09/ 844,237 filed on 4/25/01 "
- ☐ International Application \_\_\_\_\_ filed on \_\_\_\_\_ and which designated the U.S."

NOTE: The proper reference to a prior filed PCT application that entered the U.S. national phase is the U.S. serial number and the filing date of the PCT application that designated the U.S.

NOTE: (1) Where the application being transmitted adds subject matter to the International Application, then the filing can be as a continuation-in-part or (2) if it is desired to do so for other reasons then the filing can be as a continuation.

(Added Pages for Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed [4-1.4]  
—page 3 of 8)

- ☐ "The nonprovisional application designated above, namely application \_\_\_\_\_, filed \_\_\_\_\_, claims the benefit of U.S. Provisional Application(s) No(s).:

APPLICATION NO(S): FILING DATE

\_\_\_\_\_/\_\_\_\_\_"  
\_\_\_\_\_/\_\_\_\_\_"  
\_\_\_\_\_/\_\_\_\_\_"

### C. Publication of International Application—Provisional Application

NOTE: 35 U.S.C. 154 Contents and term of patent; provisional rights.

#### (d)(4) REQUIREMENTS FOR INTERNATIONAL APPLICATIONS—

(A) *EFFECTIVE DATE.*—The right under paragraph (1) to obtain a reasonable royalty based upon the publication under the treaty defined in section 351(a) of an international application designating the United States shall commence on the date on which the Patent and Trademark Office receives a copy of the publication under the treaty of the international application, or, if the publication under the treaty of the international application is in a language other than English, on the date on which the Patent and Trademark Office receives a translation of the international application in the English language.

The international application corresponding to the instant application

- ☐ was  
☐ was not

published under PCT Article 21(2) in the English language.

- ☐ An English translation of the international application is attached.

### 18. Relate Back—35 U.S.C. § 119 Priority Claim for Prior Application

NOTE: 37 C.F.R. § 1.55 Claim for foreign priority.

"(a) An applicant in a nonprovisional application may claim the benefit of the filing date of one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f), 172, and 365(a) and (b).

(1)(i) In an original application filed under 35 U.S.C. 111(a), the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. This time period is not extendable. The claim must identify the foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time period in this paragraph does not apply to an application for a design patent.

(ii) In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT."

(2) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in § 1.17(f), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.



The prior U.S. application(s), including any prior International Application designating the U.S., identified above in item 17B, in turn itself claim(s) foreign priority(ies) as follows:

Country	Appln. No.	Filed
The certified copy(ies) has (have)		
<input type="checkbox"/> been filed on _____, in prior application 0 / _____, which was filed on _____.		
<input type="checkbox"/> is (are) attached.		

**WARNING:** *The certified copy of the priority application that may have been communicated to the PTO by the International Bureau may not be relied on without any need to file a certified copy of the priority application in the continuing application. This is so because the certified copy of the priority application communicated by the International Bureau is placed in a folder and is not assigned a U.S. serial number unless the national stage is entered. Such folders are disposed of if the national stage is not entered. Therefore, such certified copies may not be available if needed later in the prosecution of a continuing application. An alternative would be to physically remove the priority documents from the folders and transfer them to the continuing application. The resources required to request transfer, retrieve the folders, make suitable record notations, transfer the certified copies, enter and make a record of such copies in the Continuing Application are substantial. Accordingly, the priority documents in folders of international applications that have not entered the national stage may not be relied on. Notice of April 28, 1987 (1079 O.G. 32 to 46).*

#### 19. Maintenance of Coadependency of Prior Application

**NOTE:** *The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the continuation application. Notice of November 5, 1985 (1060 O.G. 27).*

**A.** ☐ Extension of time in prior application

*(This item **must** be completed and the papers filed **in the prior application**, if the period set in the prior application has run.)*

- ☐ A petition, fee and response extends the term in the pending **prior** application until \_\_\_\_\_.
- ☐ A **copy** of the petition filed in prior application is attached.

**B.** ☐ Conditional Petition for Extension of Time in Prior Application

*(complete this item, if previous item not applicable)*

- ☐ A conditional petition for extension of time is being filed in the pending **prior** application.
- ☐ A **copy** of the conditional petition filed in the prior application is attached.

**20. Further Inventorship Statement Where Benefit of Prior Application(s) Claimed**

*(complete applicable item (a), (b) and/or (c) below)*

- (a) ☒ This application discloses and claims only subject matter disclosed in the prior application whose particulars are set out above and the inventor(s) in this application are

☒ the same.

- ☐ less than those named in the prior application. It is requested that the following inventor(s) identified for the prior application be deleted:

---

*(type name(s) of inventor(s) to be deleted)*

- (b) ☐ This application discloses and claims additional disclosure by amendment and a new declaration or oath is being filed. With respect to the prior application, the inventor(s) in this application are

☐ the same.

- ☐ the following additional inventor(s) have been added:

---

*(type name(s) of inventor(s) to be deleted)*

- (c) ☒ The inventorship for all the claims in this application are

☒ the same.

- ☐ not the same. An explanation, including the ownership of the various claims at the time the last claimed invention was made

☐ is submitted.

☐ will be submitted.

**21. Abandonment of Prior Application (if applicable)**

- ☐ Please abandon the prior application at a time while the prior application is pending, or when the petition for extension of time or to revive in that application is granted, and when this application is granted a filing date, so as to make this application copending with said prior application.

*NOTE: According to the Notice of May 13, 1983 (103, TMOG 6-7), the filing of a continuation or continuation-in-part application is a proper response with respect to a petition for extension of time or a petition to revive and should include the express abandonment of the prior application conditioned upon the granting of the petition and the granting of a filing date to the continuing application.*

**22. Petition for Suspension of Prosecution for the Time Necessary to File an Amendment**

**WARNING:** "The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all the claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds of art of record in the next Office action if they had been entered in the earlier application." M.P.E.P. § 706.07(b), 7th ed.

*NOTE: Where it is possible that the claims on file will give rise to a first action final for this continuation application and for some reason an amendment cannot be filed promptly (e.g., experimental data is being gathered) it may be desirable to file a petition for suspension of prosecution for the time necessary.*

*(check the next item, if applicable)*

- ☐ There is provided herewith a Petition To Suspend Prosecution for the Time Necessary to File An Amendment (New Application Filed Concurrently)

(Added Pages for Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed [4-1.4]  
—page 6 of 8)

**23. Small Entity** (37 C.F.R. § 1.28(a))

- ☒ Applicant has established small entity status by the filing of a statement in parent application 09 / 844,237 on 4/25/01.
- ☐ A copy of the statement previously filed is included.

**WARNING:** See 37 C.F.R. § 1.28(a).

**WARNING:** "Small entity status must not be established when the person or persons signing the . . . statement can unequivocally make the required self-certification." M.P.E.P. § 509.03, 7th ed. (emphasis added).

**24. NOTIFICATION IN PARENT APPLICATION OF THIS FILING**

- ☒ A notification of the filing of this

*(check one of the following)*

- ☐ continuation
- ☐ continuation-in-part
- ☒ divisional

is being filed in the parent application, from which this application claims priority under 35 U.S.C. § 120.

**ADDED PAGE(S) FOR APPLICATION TRANSMITTAL WHERE BENEFIT OF  
A PRIOR U.S. APPLICATION CLAIMED**

Added page \_\_\_\_\_

(Added Pages for Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed [4-1.4]  
—page 8 of 8)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Nicholls et al.**Application No.: **09 / 844,237** Group No.: **2875**Filed: **April 25, 2001** Examiner: **John A. Ward**For: **OPTICALLY MARKED SURFACE**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

NOTIFICATION OF FILING OF CONTINUING,  
DIVISIONAL OR CONTINUED PROSECUTION APPLICATION

Notification is hereby being made of the filing of a:

- ☐ continuation  
☐ continuation-in-part  
☒ divisional  
☐ continued prosecution

application for this case

- ☒ concurrently herewith.  
☐ on \_\_\_\_\_ Date

## CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\*

(When using Express Mail, the Express Mail label number is mandatory;  
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

## MAILING

- ☒ deposited with the United States Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10 \*

- ☐ with sufficient postage as first class mail. ☒ as "Express Mail Post Office to Addressee"  
Mailing Label No. EL558326296US (mandatory)

## TRANSMISSION

- ☐ facsimile transmitted to the Patent and Trademark Office, (703) \_\_\_\_\_

Signature

Date: August 19, 2003Rowland Richards, Reg. No. 42,104

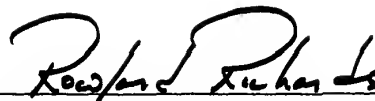
(type or print name of person certifying)

\* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

Reg. No. 42,104

Tel. No.: (716) 847-7069

Customer No.: 001342



SIGNATURE OF PRACTITIONER

Rowland Richards

(type or print name of practitioner)

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